

it would have been obvious to one of ordinary skill in the art to modify Freedman to include the memory unit that stores multiple additional images, as taught by Markowitz.

The rejection is respectfully traversed.

In imposing a rejection under 35 U.S.C. §103, the Examiner is charged with the initial burden of identifying a source in the applied prior art for the requisite motivation to combine references with a reasonable expectation of achieving a specific result. *Smiths Industries Medical Systems v. Vital Signs*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). That burden has not been discharged. In this respect, Applicant would stress that the requisite motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103 is not an abstract concept, but must stem from the applied prior art as a whole and have realistically impelled one having ordinary skill in the art to modify a specific reference in a specific manner to arrive at a specifically claimed invention. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). It has been judicially held that a generalization does not establish the requisite legal motivation to modify a specific reference in a specific manner to arrive at a specifically claimed invention. *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995).

In applying the above legal tenet to the exigencies of this case, Applicants submit that the Examiner's obviousness conclusion is legally erroneous as it lacks the requisite motivational element to combine the references to meet the terms of the claims. Since the Examiner provides no motivation to combine the references to meet the terms of the claims, the only conclusion is that the motivation is found in Applicants' disclosure, which can not be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

In addition, in Freedman, as admitted by the Examiner, there is no memory for storing multiple additional images. In this regard, since no multiple additional images are memorized, it naturally follows that the concept of "selection" does not exist. Consequently, an alternation means for altering fees based on selected additional images, is also absent.

Markowitz barely discloses the fact that multiple additional images are memorized, let alone that a control of some sort or other is effected, depending on additional images, or that fees are altered based on selected additional images. Given these fact, the claimed invention does not result even if the teaching of Markowitz were some combined with the arrangement of Freedman. More specifically, if the teaching of Markowitz were some combined with the arrangement of Freedman, such combination would have no alteration means for altering fees based on selected additional images, as there is nothing in these references that evinces that such an alteration means is even considered.

Consequently, claim 12 is patentable over Freedman and Markowitz, considered alone or in combination, and its allowance is respectfully solicited.

II. Claim 13 is rejected under 35 U.S.C. § 102(b) as being anticipated by Freedman (USPN 4,839,829).

The rejections is respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000);

*Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

There is a significant difference between the claimed invention and the arrangement disclosed by Freedman that scotches the factual determination that Freedman identically describes the claimed inventions within.

More specifically, while Freedman mentions the idea of providing various job costs, there is clearly no disclosure or suggestion of displaying the information concerning altered fees on the display, as is required in claim 13.

The above difference between the claimed system and the system of Freedman undermines the factual determination that Freedman identically describes the claimed invention within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claim 13 under 35 U.S.C. § 102 for lack of novelty as evidenced by Freedman, is not factually or legally viable. Consequently, withdrawal of the rejection of claim 13 under 35 U.S.C. § 102(b), as well as the allowance of claim 13, is respectfully solicited.

## **CONCLUSION**

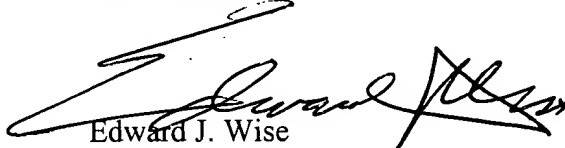
Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an

interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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